

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1-45 have been rejected. No claims have been amended, and no new matter has been added. Accordingly, Claims 1-45 will be pending in the present application upon entry of this Amendment and Reply.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. § 102

On page 2 of the Office Action, Claims 22-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,141,653 to Conklin et al. The Applicants respectfully traverse this rejection. At least one element of each of the independent claims (and, accordingly, at least one element of each of the corresponding dependent claims) is not identically disclosed by Conklin et al.

Conklin et al. is directed to a “system for iterative, multivariate negotiations over a network” including a “multivariate negotiations engine for iterative bargaining which . . . allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms, request sample quantities, and track activity; allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as prices, terms, conditions etc., iteratively with a buyer” (see Conklin et al. at col. 13, line 66 through col. 14, line 11). Conklin et al. also indicates that a “buyer might either propose negotiations of order terms based on a seller's catalog and price lists or send out a request for proposal (RFP) to all or some of the seller's in the community, or send out a request for a quote (RFQ) to all or some of the sellers in a community, asking sellers to respond with the best, most comprehensive terms each seller can offer (see Conklin et al. at col. 20, lines 24-31).

Claim 22 is in independent form and recites a “method for purchasing customized capital equipment products in an electronic marketplace” comprising, in combination with other elements, “providing customer specifications for a customized capital equipment product to a product provider using the electronic device; viewing a price quotation for the customized capital equipment product using the electronic device” (emphasis added). Claims 23-32 depend from independent Claim 22.

Claim 22 thus explicitly requires that customer specifications for a customized capital equipment product be provided. As described in the previous Amendment and Reply, Conklin et al. does not disclose the provision of such specifications. For example, Conklin et al. states at column 19, lines 61-66 as follows:

If a buyer is interested in opening negotiations with a particular seller, the propose orders processes can be based on catalog prices or desired price and other terms, special orders for samples or small quantities, proposed payment vehicles, and can include information about the buyer.

The above excerpt from Conklin et al. does not, however, disclose the customization or modification of existing products based on customer requirements. The “special orders” appear to refer to “samples or small quantities,” with no mention of any customization of existing equipment based on unique customer requirements. Such a teaching is wholly absent from the disclosure of Conklin et al.

In response to the Applicants’ arguments presented in the previous Amendment and Reply, the Examiner stated at pages 9-10 of the Office Action:

The Examiner notes that Conklin discloses a method for iterative bargaining and purchasing over a network which enables buyers and sellers to negotiate prices, terms, and conditions iteratively until an agreement is reached on all points (col. 13, lines 51-55). Conklin does disclose seller’s product catalogs or inventory tracking systems which the seller can integrate to the system (col. 28, lines 23-25). Furthermore, Conklin discloses buyer’s propose orders which can be based on the catalogs and special orders (col. 19, lines 63-65) and a negotiation of order terms (col. 20, lines 24-25), wherein the proposed orders can be a request for a quote or a request for

proposal (col. 20, lines 25-31). Moreover, Conklin discloses the alerting of sellers and buyers that pending offer or counteroffer has been submitted, so that they may return to the system to negotiate or resume negotiations (col. 19, lines 31-34).

Such method of purchasing over a network; proposing orders based on the catalogs and special orders and a negotiation of order terms, wherein the proposed order can be a request for a quote; and the alerting of buyers and seller that offers have been submitted are considered a method for purchasing customized capital equipment products comprising providing customer specification for a customized capital equipment product for product provider; and viewing a price quotation.

It does not appear from this excerpt that the Examiner has identified any portion of Conklin et al. that discloses a specification for a customized capital equipment product. Nowhere in Conklin et al. is there any disclosure that orders from catalogs, special orders for samples or small quantities, requests for proposals, or requests for quotation are the same as providing a specification for a customized capital equipment product. The importance of providing a method for ordering customized capital equipment is described at length in the present specification.

Accordingly, Conklin et al. does not identically disclose a “method for purchasing customized capital equipment products in an electronic marketplace” comprising, in combination with other elements, “providing customer specifications for a customized capital equipment product to a product provider using the electronic device; viewing a price quotation for the customized capital equipment product using the electronic device” as recited in independent Claim 22. Claim 22 is therefore patentable over Conklin et al. Dependent Claims 23-32, which depend from independent Claim 22, are also patentable.

The rejection of Claims 22-32 should be withdrawn, because at least one limitation of each of independent Claim 22 is not identically disclosed by Conklin et al. Accordingly, the Applicants request reconsideration and withdrawal of the rejection of Claims 22-32 under 35 U.S.C. § 102(e).

Claim Rejections – 35 U.S.C. § 103(a)

On page 4 of the Office Action, Claims 1-21 and 33-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,141,653 to Conklin et al. in view of U.S. Patent Application No. 5,260,866 to Lisinski et al. The Applicants respectfully traverse this rejection.

As described above, Conklin et al. relates to a “system for iterative, multivariate negotiations over a network” including a “multivariate negotiations engine for iterative bargaining which . . . allows a buyer/participant to search and evaluate seller information, propose and negotiate orders and counteroffers that include all desired terms, request sample quantities, and track activity; allows a seller/participant to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as prices, terms, conditions etc., iteratively with a buyer” (see Conklin et al. at col. 13, line 66 through col. 14, line 11).

In contrast, Lisinski et al. is related to an “expert configurator” that includes a “multi-level system for generating multiple custom work orders for the manufacturing of an end item and lower-level configurable items comprising the end item” (see Lisinski et al. at col. 2, lines 60-63). As noted by Lisinski et al., while “the present invention as embodied in expert configurator 100 is initiated by and receives information from customer service module 101, a customer service module is not required for operation of the present invention” (see Lisinski et al. at col. 7, lines 38-42).

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references (see, e.g., M.P.E.P. § 2143). This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 USPQ.2d 1788 (Bd. Pat. App. & Inter. 1986). As noted by the Federal Circuit, the “factual inquiry whether to combine references must be thorough and searching.” McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ.2d 1001 (Fed. Cir. 2001). Further, it “must be based on objective evidence of record.” In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

The Applicants submit that the Examiner has not satisfied the burden of showing that there is a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the teachings of the cited references in the manner suggested. For example, the Examiner stated in the Office Action (with emphasis added):

Lisinski, on the other hand, teaches a module of customizing configuration of a product based on requirements received from a customer and means for configuring a standard product to includes [sic] features based on needs of a particular customer and generating a price quotation

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Conklin, to include the module of customizing a configures [sic] of a product and a means for configuring, as taught by Lisinski, in order to generate custom work orders for the item corresponding to the options selected by the user for the configured parts. . . .

The Applicants submit that statement by the Examiner is inadequate to provide a proper motivation to one of ordinary skill in the art to modify the teachings of Conklin et al. in the manner suggested by the Examiner.

For example, while the cited references may both generally relate to the purchase of goods, the Examiner has not provided any indication that the cited references include any statement whatsoever that it would be desirable or even possible to combine their teachings. Conklin et al. does not indicate that it would be desirable to allow a customer to prepare a customized work order, for example. Nor does Lisinski et al. indicate that one may use the system disclosed therein in conjunction with a system such as that disclosed in Conklin et al.

Because the references are directed to entirely different systems, there is also no teaching or suggestion that it would even be possible to combine their teachings in the manner suggested by the Examiner. For example, there is no teaching in either of the references as to how their respective systems could be made to work together to provide a system with all elements recited in the rejected claims.

As noted by the Federal Circuit, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added); see also M.P.E.P. § 2143.01. It is the combination of elements recited in the claims that must be taught or suggested by the art. It is not sufficient to simply point out that various features are shown in various unrelated references. The only suggestion to make the combination recited in the rejected claims comes from the Appellants' own disclosure, and improper hindsight reasoning may not be used to render such a combination obvious.

The rejection of Claims 1-21 and 33-45 should be withdrawn, because the Examiner has not shown that one of ordinary skill in the art would have been motivated at the time of the invention to combine the teachings of Conklin et al. with those of Lisinski et al. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-21 and 33-45 is respectfully requested by the Applicants.

* * *

It is submitted that each outstanding objection and rejection to the Application has been overcome, and that the Application is in a condition for allowance. The Applicants request consideration and allowance of all pending Claims 1-45.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 7/19/2005

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